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William Jackson Bushnell

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EXAMINER

JUNTIMA, NITTAYA

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/825,645

Applicant(s)

BUSHNELL ET AL.

Examiner

Nittaya Juntima

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 7, 10, 13, 14, 18-24 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 11, 12, 15-17 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/17/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the RCE filed on 3/18/2006.
2. Claims 3-4, 7-10, 13-14, 18-24, and 26-30 were been cancelled.
3. Claims 1-2, 5-6, and 12 are currently rejected under 35 U.S.C. 112, first paragraph.
4. Claims 11-17 and 25 are currently rejected under 35 U.S.C. 112, second paragraph
5. Claims 1, 2, 6, 11, 12, 16, and 17 are currently rejected under 35 U.S.C. 102(e)

### ***Claim Objections***

6. Claims 1, 10, 11, 12, and 25 are objected to because of the following informalities:
  - in claim 1, line 10, "selected" should be inserted before "switch;"
  - line 12, ""means" should be changed to "mean;"
  - in claim 5, line 10, "means" should be changed to "mean;"
  - in claim 11, line 15, "means" should be changed to "mean;"
  - in claim 12, line 3, "a" should be changed to "the;"
  - in claim 25, line 28, "means" should be changed to "mean."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-2, 5-6, and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matters which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as follows:

In claim 1, the limitation “wherein the phone comprises first and second phones” in line 6 is not enabling. How can a single phone comprise two other phones? And, how can the second phone (126 *or* 130 in Fig. 1), which is claimed to be part of “the phone,” comprise the connector component that is connectable through the packet network to any selected one ore more of the switch components as recited in lines 2-3 of the claim?

In claim 1, the limitation “the switch components adapted to provide the first phone with a shared call appearance with the second phone” in lines 7-8 is not enabling. How can the switch components (SW1 166 and SW2 168 in Fig. 1) provide the first phone (VoIP phone 124) with a shared call appearance with the second phone (telephone 126 *or* telephone 130)? Fig. 1 shows only one switch (i.e. SW1 or SW2), not both, provides the first phone 124 with a shared call appearance with the second phone, i.e. 126 or 130.

In claim 2, the limitation “the switch components provide the first phone with a shared call appearance with the second phone through two independent paths through the packet network” in lines 1-4 is not enabling. Fig. 1 shows only one switch component providing the first phone with a shared call appearance with the second phone, i.e. the switch component SW1 providing the first phone 124 with a shared call appearance 182 with the second phone 126 *or* the switch component SW2 providing the first phone 124 with a shared call appearance 184 with the second phone 130. No where in the specification or drawings teaches that the switch

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components (SW1 166 and SW2 168 in Fig. 1) provide the first phone (VoIP phone 124) with a shared call appearance (182 *or* 184) with the second phone (telephone 126 *or* telephone 130) through two independent paths through the packet network (119).

In claim 5, the limitation “the phone comprises a first phone” in line 6 is not enabling. How can a single phone comprise another phone?

In claim 12 the limitation “the switch components provide the first phone with a shared call appearance with the second phone where the first and second phones are connected to switch components over first and second independent paths through the packet network” in lines 1-5 is not enabling. Fig. 1 only shows one switch component providing the first phone with a shared call appearance with the second phone, i.e. the switch component SW1 providing the first phone 124 with a shared call appearance 182 with the second phone 126 or the switch component SW2 providing the first phone 124 with a shared call appearance 184 with the second phone 130. Nowhere in the specification or drawings teaches how the switch components (SW1 166 and SW2 168 in Fig. 1) provide the first phone (VoIP phone 124) with a shared call appearance (182 *or* 184) with the second phone (telephone 126 *or* telephone 130) through first and second independent paths through the packet network (119).

*The applicant is strongly encouraged to carefully review and revise the above claim limitations and, if applicable, the related limitations in order to overcome the 112, first paragraph rejection.*

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 11-17 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, the limitation “selecting the phone to comprise a first phone” in line 9 is vague and indefinite. It is unclear how the step of selecting the phone, which is a method step, comprises a first phone, which is an object. And, how can the phone comprise another phone, i.e. a first phone?

In claim 15, the limitation “selecting the first phone to comprise a second shared call appearance with a third phone..” in line 2 is vague and indefinite. It is unclear how the step of selecting the first phone comprises a second shared call appearance.

In claim 16, the limitation “selecting the first phone to comprise a connector component..” in line 5 is vague and indefinite. It is unclear how the step of selecting the first phone comprises a connector component. The step of selecting is a method step, but a connector is an object. Also, is this connector component the same as the connector component recited in lines 2-3 of claim 11? If so, why are they being called differently?

In claim 17, the limitation “selecting the phone to be registrable..” in line 4 is vague and indefinite. How can the step of selecting the first phone, which is a method step, be registrable?

In claim 25, the limitation “means in the medium for selecting the phone to comprise a connector component..” in line 12 is vague and indefinite. How can the means in the medium for selecting the phone, which is supposed to be instruction(s), comprise a connector component? Or how can the step of selecting the phone comprise a connector component? Also, is this

connector component the same as the connector component recited in line 3 of the claim? If so, why are they being called differently?

In claim 25, the limitation “means in the medium for selecting the phone to comprise a first phone” in line 19 is vague and indefinite. How can the means in the medium for selecting the phone, which is supposed to be instruction(s), comprise a first phone? Or how can the step of selecting the phone comprise a first phone? In addition, the phone cannot comprise another phone, i.e. a first phone.

In claim 25, the limitation “means in the medium for selecting the phone to comprise a shared call appearance..” in line 20 is vague and indefinite. How can the means in the medium for selecting the phone, which is supposed to be instruction(s), comprise a shared call appearance? Or how the step of selecting the phone comprise a shared call appearance?

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 2, 6, 11, 12, 16, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gidwani (USPN 6,640,239 B1).

*The following rejection is based on the office's interpretation of the claim limitations in view of the 112, first paragraph and second paragraph rejections.*

Regarding claim 1, as shown in Fig. 14, Gidwani teaches a system, comprising:

A first phone (PC 804 acting as a computer phone) that comprises a connector component (inherent interface) that is operationally connectable through a packet network (UIP Server 830 comprising WAN switch 380 in Fig. 4 and Internet 158 constitute a packet network) to a selected one (a class 5 switch 834 in PSTN 280) of a plurality of switch components (834, 838, 840 in PSTN 280). See col. 42, lines 15-25, see also col. 27, lines 39-41, 46-56, col. 28, lines 14-35.

Wherein the selected one (class 5 switch 834) of the plurality of switch components serves to provide one or more originating and terminating telecommunication service to the phone (switch 834 must originate/terminate voice call to/from phone 124 to PC phone 804 col. 42, lines 49-56).

Wherein the selected switch component (class 5 switch 834) provides the first phone (PC phone 804) with a shared call appearance with a second phone (phone 102) through the packet network (UIP Server 830 comprising WAN switch 380 in Fig. 4 and Internet 158 constitute a packet network), and wherein the second phone (phone 102) comprises the shared call appearance with the first phone (PC phone 804) over the selected switch component (class 5 switch 834) and through a network (UIP Server 830) (since both phone 102 and PC phone 804 share a telephone number via the UIP client 224 as shown in Fig. 18, col. 44, lines 31-35, therefore, both phone must have a shared call appearance with each other over the switch 834 when originating/terminating call to/from another POTS phone).

Wherein the first and second phones are not connected to each other as extension phones (see Fig. 14).

Wherein the shared call appearances of the first and second phones mean the second phone serves as an electronic implementation of an extension of the first phone (both phone 102 and PC phone 804 share a telephone number via the UIP client 224 as shown in Fig. 18, col. 44, lines 31-35).

Regarding claim 2, as shown in Fig. 14, Gidwani further teaches that the selected switch component (class 5 switch 834) provide the first phone (PC phone 804) with the shared call appearance with the second phone (phone 102) through an independent path (834-830-798-224-102 and 804) through the packet network (UIP Server 830 comprising WAN switch 380 in Fig. 4 and Internet 158 constitute a packet network) (both phone 102 and PC phone 804 share a telephone number via the UIP client 224 as shown in Fig. 18, col. 44, lines 31-35).

Regarding claim 11, as shown in Fig. 14, Gidwani teaches a method, comprising the steps of:

Selecting a first phone (PC phone 804) that comprises a connector component (inherent interface) that is operationally connectable through a packet network (UIP Server 830 comprising WAN switch 380 in Fig. 4 and Internet 158 constitute a packet network) to a selected one (a class 5 switch 834 in PSTN 280) of a plurality of switch components (834, 838, 840 in PSTN 280). See col. 42, lines 15-25, see also col. 27, lines 39-41, 46-56, col. 28, lines 14-35.

Wherein the selected one (class 5 switch 834) of the plurality of switch components serves to provide one or more originating and terminating telecommunication service to the

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phone (switch 834 must originate/terminate voice call to/from phone 124 to PC phone 804 col. 42, lines 49-56).

Providing communications to the first phone so that the first phone has a shared call appearance with a second phone (phone 102) over the selected switch component through the packet network, wherein the second phone (phone 102) comprises the shared call appearance with the first phone (PC phone 804) over the selected switch component (class 5 switch 834) and through a network (UIP Server 830) and the first and second phones not being connected to each other as extension phones (since both phone 102 and PC phone 804 share a telephone number via the UIP client 224 as shown in Fig. 18, col. 44, lines 31-35, therefore, both phone must have a shared call appearance with each other over the switch 834 when originating/terminating call to/from another POTS phone).

Wherein the shared call appearances of the first and second phones mean the second phone serves as an electronic implementation of an extension of the first phone (both phone 102 and PC phone 804 share a telephone number via the UIP client 224 as shown in Fig. 18, col. 44, lines 31-35).

Regarding claim 12, as shown in Fig. 14, Gidwani further teaches that the selected switch component (class 5 switch 834) provide the first phone (PC phone 804) with the shared call appearance with the second phone (phone 102) where the first and second phones are connected to the selected switch component over a first independent path (834-830-798-224-102 and 804) through the packet network (UIP Server 830 comprising WAN switch 380 in Fig. 4 and Internet 158 constitute a packet network) (both phone 102 and PC phone 804 share a telephone number via the UIP client 224 as shown in Fig. 18, col. 44, lines 31-35).

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Regarding claim 16, Gidwani teaches that the connector component (inherent interface inside PC phone 804) is operationally connectable through the packet network (UIP Server 830 comprising WAN switch 380 in Fig. 4 and Internet 158 constitute a packet network) to the selected switch component (switch 834) through a respective one of a plurality of voice over IP gateways (in order for the call from another POTS phone such as phone 124 to terminate on both PC phone 804 and phone 102 which share the same phone number, col. 44, lines 31-35, PC phone 804 must be connected to a VoIP gateway as similarly shown in Fig. 1 when a call from switch 144 must be converted to VoIP call via a respective CO VoIP gateway 148 and routed to ATM switch 140 to be terminated to a VoIP phone connected to a DSL).

Regarding claim 17, it is inherent that the first phone must be registrable with the selected VoIP gateway (in order for the call from another POTS phone such as phone 124 to terminate on both PC phone 804 and phone 102 which share the same phone number, col. 44, lines 31-35, PC phone 804 must be registrable with the selected VoIP gateway as similarly shown in Fig. 1 when a call from switch 144 must be converted to VoIP call via a respective CO VoIP gateway 148 and routed to ATM switch 140 to be terminated to a VoIP phone connected to a DSL).

***Allowable Subject Matter***

13. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima  
May 22, 2006

*NJ*

  
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